

Oral Hearing:
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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Rockline Industries, Inc.
v.
Dental Disposables International, Inc.

Cancellation No. 28,732

David Hanson, Jason E. Pauls, Beth Ermatinger Hanan and Peter
W. Becker of Reinhart, Boerner, Van Deuren, Norris &
Rieselbach, s.c. for Rockline Industries, Inc.

Jennifer Haeckl and Brian M. Dingman of Mirick, O'Connell,
DeMallie & Lougee, LLP for Dental Disposables International,
Inc.

Before Hohein, Hairston and Bucher, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Rockline Industries, Inc. has petitioned to cancel
the registration owned by Dental Disposables International,
Inc. for the mark "FRESHEN UP" for "pre-moistened dental

patient wipes."¹ As grounds for cancellation, petitioner alleges that, since at least as early as 1993 (and thus prior to respondent's claimed dates of first use of March 13, 1996), petitioner has adopted and continuously used the mark "FRESH'N UP" in connection with "pre-moistened wipes"; that it has filed an application, Serial No. 75/321,460, to register such mark for "various goods" which "has been refused registration by the United States Patent and Trademark Office under § 2(d) of the Trademark Act as a result of Registrant's Registration No. 2,174,347"; and that respondent's contemporaneous use of its "FRESHEN UP" mark "on goods closely related to the goods sold by Petitioner" under its "FRESH'N UP" mark is likely to cause confusion, mistake or deception.

Respondent, in its answer, has admitted that "its date of first use in commerce, as stated in Registrant's registration, is March 13, 1996," but otherwise has denied the salient allegations of the petition to cancel.

The record includes the pleadings; the file of the involved registration; and, as petitioner's case-in-chief: a notice of reliance upon, inter alia, excerpts from certain printed publications and respondent's responses to

¹ Reg. No. 2,174,347, issued on July 21, 1998 from an application filed on October 21, 1996, which sets forth a date of first use anywhere and in commerce of March 13, 1996.

petitioner's first set of requests for admissions;² the affidavit of Ronald A. Kerscher, submitted pursuant to a stipulation by the parties;³ and the testimony, with exhibits, of Ronald A. Kerscher, who is petitioner's vice president of sales and marketing.⁴ Respondent, by stipulation of the

² Such notice, which is entitled "NOTICE OF RELIANCE UPON DISCOVERY," also purports to rely upon pages "from the internet website of Registrant copied on February 9, 2000," "a copy of one of Registrant's product labels," "a copy of wrappers or labels from five of Petitioner's products" and "color copies of trade sheets depicting product labels for Petitioner's ... products." None of such materials, however, constitutes proper subject matter for a notice of reliance under the provisions of either Trademark Rules 2.120(j)(3) or 2.122(e). Nevertheless, inasmuch as respondent states in its brief that it agrees with petitioner that such items form part of the record herein, the evidence is considered to be of record by stipulation of the parties under Trademark Rule 2.123(b). See TBMP Section 708 and *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1369-70 (TTAB 1998).

³ Although the description of the record in petitioner's main brief refers to "the Affidavit of Ronald A. Kerscher and exhibits identified therein," it is noted that no exhibits were identified in such affidavit and none are attached thereto.

⁴ While such testimony, which was taken on March 14, 2000, consists essentially of respondent's cross-examination of the witness with respect to the statements made by Mr. Kerscher in his affidavit, it is noted that petitioner's initial testimony period closed in this matter on February 25, 2000. Although petitioner filed a timely motion for a 60-day extension of such period, respondent opposed the requested extension and petitioner subsequently filed a motion to dismiss its motion for an extension of time, stating as the basis therefor that the parties "have stipulated in writing that the testimony of any witness or witnesses of each party may be submitted in ... an affidavit by such witness or witnesses, with each party reserving the right to cross examine by oral deposition the other party's affiants." Trademark Rule 2.121(a)(1) provides, however, that "[n]o testimony shall be taken except during the times assigned, unless by stipulation or the parties approved by the Board, or, upon motion, by order of the Board." In view thereof, petitioner's motion to dismiss its motion for an extension of time is granted and, inasmuch as the parties' stipulation is approved, the testimony is considered to form part of the record in this proceeding pursuant to Trademark Rules 2.121(a)(1) and 2.123(b).

parties, has made of record as its case-in-chief the affidavit, with exhibits, of Jack I. Graham and the testimony, with exhibits, of Jack I. Graham, who is respondent's co-owner, vice president and treasurer.⁵ Petitioner, as its rebuttal, furnished by stipulation of the parties the affidavit, with an exhibit, of Carmen A. Baker, who is its product/project manager.⁶ Briefs, consisting of a main brief from each party and petitioner's reply brief,⁷ have been filed

⁵ Such testimony, which was taken on May 17, 2000, essentially consists of petitioner's cross-examination of the witness with respect to the statements made by Mr. Graham in his affidavit, which was signed on April 25, 2000, the closing date of respondent's testimony period. In view of the approval of the parties' stipulation, the testimony is regarded as forming part of the record herein in accordance with Trademark Rules 2.121(a)(1) and 2.123(b).

⁶ The accompanying notice of reliance thereon is superfluous. In addition, while petitioner asserts in its main brief that the record also includes an affidavit from one of its attorneys, along with the exhibits thereto, we sustain the objection by respondent in its brief that "the Affidavit of Jason E. Pauls and exhibits identified therein are not a matter of record in this case" inasmuch as such were filed, after the close of all testimony periods herein, with petitioner's reply to its motion to compel respondent to supplement discovery.

⁷ Petitioner, in its reply brief, has moved to strike respondent's main brief as untimely and respondent, in turn, has filed a motion for leave to file a surreply to petitioner's reply brief, to which petitioner has timely filed its opposition. As to the request to strike, petitioner is correct that respondent's main brief, which is not accompanied by either a certificate of mailing or a certificate of service, is clearly untimely inasmuch as such brief, which was due by September 7, 2000, was not received by the Board until September 12, 2000. Contrary to respondent's contention that, under Trademark Rule 2.119(c), it had an additional five days in which to file its main brief, such rule is not applicable to any action, including the due date for filing a brief on the case, which must be taken by a party within a time set in a communication from the Board. TBMP Section 113.05. However, pursuant to our discretion in this matter, and since the five-day delay seems minimal in light of the issues

and an oral hearing, attended by counsel for each of the parties, was held.⁸

The issues to be decided in this proceeding are which party has priority of use of its mark and, if priority lies with petitioner, whether there is a likelihood of confusion from contemporaneous use of the parties' marks in connection with their respective goods.⁹ Turning first to the

herein and petitioner consequently does not appear to have been truly prejudiced in preparing and filing its timely reply brief, the request to strike is denied and we have considered respondent's main brief. With respect to the motion for leave to file a surreply, we fail to see any need for such a brief, particularly in view of the fact that the oral hearing, at which respondent was represented by counsel, provided respondent with ample opportunity to reply to any arguments raised in petitioner's reply brief. The motion for leave to file a surreply is accordingly denied.

⁸ While much of the evidence introduced by the parties has been designated as "CONFIDENTIAL" and their briefs have been so marked, suffice it to say that, with the exception of certain proprietary business information, such as sales and advertising figures, virtually none of the evidence of record is properly regarded as confidential. Accordingly, and in order to render an opinion herein, which like all decisions issued by the Board constitutes a public record, our discussion of the evidence and issues will not be restricted except insofar as certain limited matters of proprietary business information are concerned.

⁹ Respondent, citing in particular the deposition testimony of Mr. Kerscher at 14-15 that petitioner's "criteria in selecting a name revolves around a descriptive name that describes the product line or category that we're trying to develop" and that "[f]or FRESH'N UP, when we developed that name, it was for moist towelettes with the idea that you could take one out of the canister and FRESH'N UP with it, or the other connotation for FRESH'N UP was that it kind of popped up out of the canister one at a time, thus, FRESH'N UP," has contended in its brief and at the oral hearing that there is also an issue as to whether petitioner's "FRESH'N UP" mark is merely descriptive of petitioner's pre-moistened wipes or towelettes. We find, however, that such an issue was clearly not tried by either the express or implied consent of the parties, and thus that the

determination of the former, the record shows that petitioner has continuously used its "FRESH'N UP" mark in connection with various wipes and cleaning cloths since 1993, when it adopted and commenced use thereof with respect to pre-moistened towelettes for cleaning one's hands and face. In particular, petitioner "first received a purchase order for pre-moistened wipes under its FRESH'N UP trademark in September 1993, and ... has sold and shipped pre-moistened wipes under its FRESH'N UP trademark continuously since October 1993." (Baker aff. at ¶5.) Although a "sampling of invoices from [October 6,] 1993 until [June 24,] 1996 demonstrating such use" invariably refers to the mark as "FRESH N'UP," the record confirms that the mark "FRESH'N UP" is used in connection with the actual packaging and advertising for petitioner's pre-moistened

pleadings should not be deemed to be amended pursuant to Fed. R. Civ. P. 15(b), nor in any event is the evidence sufficient to constitute proof of mere descriptiveness. Mr. Kerscher's testimony is plainly that of a layman who is unfamiliar with the technicalities of trademark law. Moreover, as petitioner has persuasively pointed out, respondent's virtually identical mark "FRESHEN UP" for essentially the same goods issued on the Principal Register without resort to the provisions of Section 2(f) of the Trademark Act, which is indicative that respondent's mark, and likewise petitioner's mark, is at most highly suggestive--and hence inherently distinctive--rather than merely descriptive, of the respective goods. We thus disagree with respondent's assertion, as stated in its brief at 14, that "as a matter of law, Rockline's unregistered mark is not inherently distinctive and, as such, Rockline was required to prove that its mark had acquired distinctiveness before Dental Disposables' first use in May 1996" of its mark.

towelettes for cleaning one's hands and face. (Id. and Petitioner's Exhibits A, 1--5, 11 and 12.)

A second kind of pre-moistened towelettes, targeted to the elderly and incontinent, was subsequently introduced by petitioner under its "FRESH'N UP" mark in 1998 along with an antibacterial version. In 1999, petitioner launched a pre-moistened towelette toilet tissue under such mark and has "plans to further expand its use of the FRESH'N UP trademark into a broader category of goods related to pre-moistened towelettes." (Kerscher aff. at ¶7.) Petitioner, in particular, is in the development phase for production of a disinfectant wipe for hard surface cleaning, which will be suitable for use in homes as well as in dental and medical offices.

Respondent, on the other hand, "selected the FRESHEN UP" trademark in 1996 for a new pre-moistened dental patient wipe product" which it "began selling ... in interstate commerce in March, 1996." (Graham aff. at ¶5.) Since that time, respondent "has ... continuously used the mark on those goods throughout the United States." (Id.) However, as attested to by Mr. Graham, the sole invoice "evidencing our shipment of 20 boxes of FRESHEN UP patient wipes ... from our New Jersey location to a dental products distributor called Patterson Dental, in Jacksonville, Florida," is dated May 30,

1996, rather than sometime in March 1996, and refers to "FRESHENUP PATIENT WIPES," instead of "FRESHEN UP PATIENT WIPES." (Id. and Respondent's Exhibit 3.)

On cross-examination, Mr. Graham admitted that respondent first sold pre-moistened patient wipes or towelettes under its "FRESHEN UP" mark in May of 1996. Specifically, while claiming that respondent had selected the mark "FRESHEN UP" for such goods by as early as January of 1996 or as late as March 13, 1996, he conceded that the actual first sale of the goods under the mark was its May of 1996 sale thereof to Patterson Dental. The discrepancy between the May 30, 1996 date of that sale and both the March 13, 1996 date of first use set forth in respondent's involved registration and the March of 1996 date of first use attested to in his affidavit, Mr. Graham explained, was "[p]ossibly [because] we had chosen the name, ordered the product and didn't sell it until May." (Graham dep. at 56.)

We find, in light of the above, that while both parties have continuously used their respective marks, it is petitioner that has priority of use. This is because petitioner first used its "FRESH'N UP" mark in connection with pre-moistened wipes or towelettes at least as early as October 6, 1993 while respondent did not commence use of its "FRESHEN UP" mark, as opposed to the adoption thereof, with respect to

pre-moistened dental patient wipes until May 30, 1996 at the earliest.¹⁰

Turning, therefore, to the issue of likelihood of confusion, the record reveals that petitioner is a privately held company with sales of all of its products having grown tenfold during the period from 1985 to 1999. Petitioner is "primarily a paper converter," in that it "buys large ... rolls of paper from a paper mill and then converts it into various products" such as coffee filters, baking cups and wet wipes, although it also buys "some ... vendor made items ... from other companies" which it "resell[s] under our platform." (Kerscher dep. at 7.) Currently, petitioner's product categories "include baby wipes, moist toilet tissue, adult incontinent wipes, antibacterial hand and face wipes, coffee filters, baking cups, coffee maker cleaners, [and] a wide range of commercial coffee related products." (Id. at 8.) Petitioner uses its "FRESH'N UP" mark for all of its wet wipe or moist towelette products other than its baby wipe products.

¹⁰ Although, as previously noted, the invoices supporting the testimony offered by the parties concerning their dates of first use evidence use of the mark "FRESH N'UP" in the case of petitioner and "FRESHENUP" in the case of respondent, it is plain that the former is the legal equivalent of petitioner's "FRESH'N UP" mark just as the latter is the legal equivalent of respondent's "FRESHEN UP" mark. In each instance, such pairs of marks create the same continuing commercial impression and thus each party, for priority purposes, may tack the use of its previously used mark to the use of its present mark. See, e.g., Van Dyne-Crotty Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866, 1868 (Fed. Cir. 1991).

In addition to manufacturing and selling its own brands throughout the United States, petitioner is "a private label manufacturer" in that it "make[s] brands for people like K-Mart and Wal-Mart and Stop 'N Shop and Shaws." (Id. at 10.)

Petitioner sells its "FRESH'N UP" goods directly to retail food and drug outlets, mass merchandisers, wholesalers and distributors, including "accounts such as Military Dist., Inc., Wal-Mart, Sam's Club, Amway, Professional Medics, and Med-America." (Kerscher aff. at ¶16.) Petitioner has also sold such products to state health departments and its goods are sold in every state of the United States. Moreover, because petitioner does not prevent or restrict where and to whom its distributors may sell its "FRESH'N UP" products, such goods may be sold to medical and dental offices.¹¹ In addition, petitioner itself "has considered marketing and selling a pre-moistened towelette under its FRESH'N UP trademark to the dental and medical field, and has not ruled out that possibility." (Id. at ¶18.) Dentists and doctors, in fact, have called petitioner to request that it "sell its FRESH'N UP products directly to those in [the] medical and

¹¹ Although, on cross-examination, Mr. Kerscher testified that he did not know whether petitioner was currently selling such goods to any distributor which in turn sold the products to the dental market, he stated that such "[c]ould be" the case because, as indicated above, petitioner will sell its "FRESH'N UP" products to any distributor interested in buying them. (Kerscher dep. at 72.)

dental industry," stating that they first saw such products "in Wal-Mart and Sam's Club stores." (Id. at ¶21.)

Petitioner, while occasionally selling directly to individuals who call and request its products, tries most of the time to direct such callers to a nearby retailer or distributor who carries its goods in their area. Requests that petitioner "sell the FRESH'N UP moist towelettes in individual packages" have also been received and, while petitioner "does not presently sell these products in packages smaller than sixteen (16) count, ... it has not ruled out the use of individual packaging for FRESH'N UP products in the future." (Id. at ¶22.) Sales of petitioner's "FRESH'N UP" products have increased from several thousand dollars in 1993 to over one hundred thousand dollars in 1996 and to over one half million dollars in 1999.

Petitioner has advertised its various wipes in several trade journals, including an ad for its moist toilet tissue in Mass Market Retailer and advertisements for its all-purpose wipes, cleaning cloths, all-purpose washcloths and adult cleansing cloths in Private Label News. "Currently," its "primary marketing for ... products labeled with the FRESH'N UP trademark is conducted by use of magazines, advertisements, trade shows, point of purchase displays, internet, and direct sales," with total advertising costs in

1999 for its "FRESH'N UP" products exceeding several tens of thousands of dollars. (Id. at ¶16.) Moreover, inasmuch as petitioner does not direct its advertising to the end users of such products, which generally are ordinary consumers, any additional advertising and marketing expenditures which are targeted to those customers are done by petitioner's retailers and distributors.

Respondent, on the other hand, was founded in 1988. It "sells products only to the dental industry," offering "about 25 products" which "are sold through dental distributors to dental offices." (Graham aff. at ¶6.) Annual sales of its dental products have exceeded several million dollars for each of the years from 1996 through 1999. In particular, respondent markets and sells pre-moistened wipes under the mark "FRESHEN UP," which its "distributor customers sell ... to dental offices in all 50 states." (Id.)

According to Mr. Graham:

The FRESHEN UP product is used by patients in dental offices after a dental procedure. The FRESHEN UP product is given by staff to a patient ... for the patient to wipe his or her hands and face, in order to clean up from the procedure.

(Id. at ¶7.) Thus, like the wrappers or labels utilized by petitioner for its "FRESH'N UP" flushable moist wipes, which bear the legend "[l]eaves you feeling clean and fresh," a label used by respondent in connection with its "FRESHEN UP"

wipes for dental patients states that "these wipes will leave your patient feeling refreshed." (Petitioner's Exhibits 11 and 10, respectively.)

Respondent's "plan and expectation [is] to continue to distribute the FRESHEN UP product only to dental offices, and only through dental products distributors." (Graham aff. at ¶7.) However, as Mr. Graham admitted on cross-examination, there are no restrictions as to where respondent's distributors may sell its "FRESHEN UP" product, although it views the ultimate customers therefor as being "[d]entists, hygienists and dental assistants." (Graham dep. at 23.) Other customers serviced by respondent's distributors include orthodontic offices. Moreover, as testified to by Mr. Graham, he is aware of dental offices which, in addition to using respondent's "FRESHEN UP" product for their patients, use another pre-moistened towelette for other dental office purposes, such as an antibacterial wipe for disinfecting needs. Although currently respondent does not sell antibacterial or other hard surface wipes, "many" of its distributors do and respondent has plans to "[p]ossibly" sell its own such goods through its distributors. (Id. at 75 and 73, respectively.)

Respondent's "FRESHEN UP" product is sold in boxes of 100 individually wrapped wipes, with the mark printed on

the wrapper for each wipe as well as on the box containing such product. Annual sales of its "FRESHEN UP" dental patient wipes have generally increased, except for 1997, rising from almost one hundred thousand dollars in 1996 to nearly one hundred fifty thousand dollars in 1999, representing a growth in quantity from around 10,000 boxes sold in 1996 to over 14,000 boxes sold by 1999. Annual advertising and marketing expenditures, however, generally have steadily decreased, dropping from over forty thousand dollars in 1996 to about fourteen thousand dollars in 1999. Respondent advertises its "FRESHEN UP" product on its website, in "periodicals" such as "Proofs, Dental Products Report, and Dentistry Today" and "in most of [its] dental distributor customers' catalogues." (Graham aff. at ¶10.) One catalogue ad, for example, refers to respondent's "FRESHEN UP" goods as "[d]isposable moist towelettes [which] leave patients' faces feeling clean and fresh after appointments" and urges dentists to "[t]ry them yourself to freshen up between patients or after long procedures." (Respondent's Exhibit 4.)

In addition, in 1996 and 1997, respondent "sent [out] approximately 400,000 FRESHEN UP product samples" to the distributors which were selling its products "for distribution to their dental office customers." (Graham aff. at ¶11.) Each year since then respondent has sent out "4,000 such free

samples." (Id.) Respondent, furthermore, annually "attends and promotes its products, including FRESHEN UP, at the following dental meetings: The American Dental Association Annual Meeting, the Greater New York Dental Meeting, the Yankee Dental Meeting, The Hinman Dental Meeting, the Chicago Midwinter Dental Meeting, and the Southern California Dental Meeting." (Id. at ¶12.) Respondent maintains a trade show booth at each of such meetings, with its annual expenditures therefor exceeding several tens of thousands of dollars. Finally, according to Mr. Graham, respondent "is not aware of a single instance of actual confusion" between its "FRESHEN UP" mark and petitioner's "FRESH'N UP" mark. (Id. at ¶13.)

Upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether a likelihood of confusion exists, we find that petitioner has met its burden of demonstrating by a preponderance of the evidence that confusion as to source or sponsorship from contemporaneous use of the parties' marks in connection with their respective goods is likely to occur. In particular, it is plain that the marks at issue are virtually identical in appearance.¹² We note, in this regard, that even respondent's

¹² Respondent's witness, Mr. Graham, implicitly admitted such by failing to note, by way of an errata sheet correction to his deposition, the transcription error which, in a discussion of a

website, as of February 9, 2000, referred to its "FRESHEN UP" individually wrapped wipes by displaying below an icon for such product the mark "FRESH'N UP," which is of course identical to petitioner's mark.¹³ Moreover, the respective marks are identical in sound and connotation. Respondent's witness, Mr. Graham, conceded on cross-examination the obvious fact that petitioner's "FRESH'N UP" mark and respondent's

distributorship agreement concerning respondent's dental patient wipes, mistakenly refers to petitioner's mark instead of respondent's mark as follows (*emphasis added*):

Q. All right. This distributorship agreement concerns a product known as Fresh Wipes?

A. No.

Q. Okay. So, the agreement is in error?

A. The name is in error.

Q. All right. What is the name?

A. *FRESH'N UPs*.

Q. As of January of 1996, were the products that were the subject of this ... agreement known as FRESHEN UP?

A. We had named the product, yes.

(Graham dep. at 53-54.)

¹³ While respondent's website, as of February 9, 2000, also misspelled its mark as "FRESH-N-UP," the picture of the packaging of the goods shown therein illustrates use of the mark "FRESHEN UP." After noticing the spelling errors, which respondent claims were caused by its website graphics designer, the mistakes were corrected by no later than May 9, 2000 and, according to Mr. Graham, such is the only instance since 1996 in which it has encountered any misspellings of its "FRESHEN UP" mark in its advertising.

"FRESHEN UP" mark sound the same. Both marks, furthermore, convey the same highly suggestive connotation. Considered in their entireties, the respective marks engender such essentially identical commercial impressions that, if used in connection with the same or substantially related goods, confusion as to the source or sponsorship of the products would be likely.

With respect to the parties' goods, petitioner among other items markets under its "FRESH'N UP" mark pre-moistened wipes or towelettes for cleaning one's hands and face. Those goods, like the products sold by respondent under its "FRESHEN UP" mark, are suitable for use as pre-moistened dental patient wipes. Such goods, the record shows, are wipes given to patients in dental offices to enable the patient to clean up after a dental procedure by wiping his or her hands and face. Although respondent, among other things, makes much of the fact that its goods, unlike those of petitioner, are sold individually wrapped, there is no such limitation or restriction in respondent's registration and it is settled, as respondent correctly notes in its brief, that the issue of likelihood of confusion must be determined on the basis of the goods as identified in the involved registration. See, e.g., Commerce Drug Co., Inc. v. Kirkman Laboratories, Inc., 461 F.2d 833, 174 USPQ 265, 267 (CCPA 1972). Because the

respective goods, in terms of their nature and use, consequently must be considered to be substantially identical, their contemporaneous sale and advertising under the virtually identical marks "FRESH'N UP" and "FRESHEN UP" would be likely to cause confusion as to the origin or affiliation of such products.

Respondent principally contends, however, that confusion is not likely because the established, likely-to-continue channels of trade for the parties' respective goods are dissimilar. In particular, respondent notes that its "FRESHEN UP" pre-moistened dental patient wipes are sold only through dental distributors to dental offices and orthodontists while petitioner's "FRESH'N UP" pre-moistened wipes or towelettes for cleaning one's hands and face are chiefly sold directly to retail food and drug outlets, mass merchandisers, wholesalers and distributors. However, as the record makes clear, petitioner does not prevent or restrict to whom or where its distributors may sell its "FRESH'N UP" products, and thus such goods may be sold to dental offices and orthodontists. Moreover, respondent asserts in its brief (at 20) that petitioner's stated claim that it has considered and not ruled out the possibility of marketing and selling a pre-moistened towelette under its "FRESH'N UP" mark to the dental (and medical) field is "belied" by petitioner's

continuing failure actually to do so. The record, however, shows that petitioner has in fact received calls from dentists, among others, requesting that it sell its "FRESH'N UP" products, which the callers first saw in mass merchandisers such as Wal-Mart and Sam's Club stores, directly to those in the dental industry and that petitioner will sell directly to individuals when it is unable to refer them to a nearby retailer or distributor of its "FRESH'N UP" products in their area. It is plain, therefore, that dentists, and hence their staffs as well, do indeed regard petitioner's "FRESH'N UP" pre-moistened wipes for cleaning one's hands and face as suitable for use by their dental patients and that the differences in the principal channels of trade for petitioner's "FRESH'N UP" goods and respondent's "FRESHEN UP" pre-moistened dental patient wipes would not be sufficient to avoid a likelihood of confusion between such marks among dentists and their staffs.

Nonetheless, respondent further argues that confusion is not likely because the record establishes that there have been no incidents of actual confusion during a period of four years of contemporaneous use by the parties of their respective marks. However, while the absence of any instances of actual confusion over a significant period of time is indeed a *du Pont* factor which is indicative of no

likelihood of confusion, it is a meaningful factor only where the record demonstrates appreciable and continuous use by the respondent of its mark in the same markets as those served by the petitioner under its mark. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In particular, there must be evidence showing that there has been an opportunity for incidents of actual confusion to occur. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000).

In this case, the absence of any instances of actual confusion is not a mitigating factor inasmuch as, while both parties nominally sell their respective goods nationwide, there is no information which establishes that the nature and extent of their sales and marketing activities under their respective marks have been in one or more of the same localized areas and thus, if is likely to occur, it would be expected to have happened. To the contrary, in the present case there is nothing which shows, for example, that the parties advertise in the same trade journals, attend and exhibit at the same trade shows, or share the same particular customers. The absence of any known instances of actual confusion, moreover, would appear to be explained by the fact that, not only are the respective goods of the parties relatively inexpensive by their very nature, but as a

practical matter the principal channels of trade therefor have been different. Circumstances, in short, have not been such that the absence of any incidents of actual confusion can be said to be probative of the lack of a likelihood of confusion.

We accordingly conclude, in light of the virtual identity of the marks at issue and the substantial identity in nature and use of the respective goods, that purchasers, such as dentists, orthodontists, hygienists and their assistants, who are familiar or acquainted with petitioner's "FRESH'N UP" mark for its pre-moistened towelettes or wipes for cleaning one's hands and face, could reasonably believe, upon encountering respondent's "FRESHEN UP" mark for its pre-moistened dental patient wipes, that such products emanate from, or are otherwise sponsored by or affiliated with, the same source.

Decision: The petition to cancel is granted and Reg. No. 2,174,347 will be cancelled in due course.